

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop 16, Director of USPTO, P.O. Box 1450, Alexandria, VA 22313-1450 on October 11, 2005.

Marilyn R. Khorsandi
Marilyn R. Khorsandi

2005 OCT 14 PM 4:21
US PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|--|---------------------------|
| Applicant(s): Daniel F. Williams, et al. | Group Art Unit: 3629 |
| Serial No.: 09/820,377 | Examiner: Jamisue A. Webb |
| Filed: March 27, 2001 | |
| Title: Apparatus, Systems and Methods for Online, Multi-Parcel, Multi-Carrier, Multi-Service Enterprise Parcel Shipping Management | |
| Atty Dckt No.: PSTM0041/MRK | |

RFST AVAILABLE COPY

REQUEST FOR REFUND UNDER
37 C.F.R. § 1.26(a)

Mail Stop 16
Director of the USPTO
P.O. Box 1450
Alexandria, VA 22313-1450

Director:

According to the U.S. PTO website, a charge in the amount of \$200.00 has been applied against USPTO Deposit Account No. 501574 with reference to the above-identified patent application during the month of August 2005, identifying fee code 1202 (claims in excess of 20). After review of the Amendment and Response, and the Request for Continued Examination, filed July 20, 2005, a copy of which is enclosed for your reference, it is respectfully submitted, for the following reasons, that the \$200 charge is in error.

An Amendment and Response, filed January 13, 2005, added, and submitted payment for, four new dependent claims. However, the Amendment and Response, and the Request for Continued Examination, filed July 20, 2005 did not add any new claims. Accordingly, it is respectfully submitted that the fees for the Amendment and Response, and the Request for Continued Examination, filed July 20, 2005 were correctly calculated and paid, and that no further fees in regard to claims in excess of 20 were due.

Therefore, applicant respectfully requests a refund of \$200.00 to USPTO Deposit Account No. 501574.

Serial No. 09/820,377
Request for Refund

Respectfully submitted,

Oct. 11, 2005
Date

Marilyn R. Khorsandi
Marilyn R. Khorsandi
Attorney/Agent for Applicant(s)
Reg. No. 45,744
Khorsandi Patent Law Group, ALC
140 S. Lake Ave., Ste. 312
Pasadena, California 91101-4710
Telephone No.: (626) 796-2856
Fascimile: (626) 796-2864

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 20, 2005.



Marilyn R. Khorsandi

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Daniel F. Williams, et al.
Application No. : 09/820,377
Filed : March 27, 2001
Title : APPARATUS, SYSTEMS AND METHODS FOR
ONLINE, MULTI-PARCEL, MULTI-CARRIER, MULTI-
SERVICE ENTERPRISE PARCEL SHIPPING
MANAGEMENT
Grp./Div. : 3629
Examiner : Webb, Jamisue A.
Docket No. : PSTM0041/MRK

AMENDMENT AND RESPONSE
WITH REQUEST FOR CONTINUED EXAMINATION

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312
Pasadena, CA 91101-4710
July 20, 2005

Commissioner:

In reply to the Office Action regarding the above-identified application, dated April 21, 2005, which was designated a final rejection, a Request for Continued Examination and the associated fee are submitted herewith, and consideration of the application in view of the Amendments and the Response and Remarks below is respectfully requested.

Amendments to the Claims are reflected in the Listing of Claims that begins on page 2 of this paper.

Response and Remarks begin on page 10 of this paper.

Application Serial No. 09/820,377
Amendment and Response with Request for Continued Examination

Amendments to the Claims:

Please amend Claims 7, 10-14, 23-24, and 26 as indicated below.

Original Claims 1-6, 8, 9, and 15-22 were previously withdrawn without prejudice.

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. (Withdrawn) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:
 - collect input of a set of shipping policy rules from an administrator of an enterprise; and
 - apply the set of shipping policy rules to each shipping request by each of a plurality of users within the enterprise.
2. (Withdrawn) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:
 - collect input from an administrator of an enterprise comprising an identification of at least one site within the enterprise; and
 - collect input from the administrator comprising a set of shipping policy rules for each of said sites.
3. (Withdrawn) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:
 - collect from an administrator of an enterprise an identification of a plurality of sites within the enterprise, an identification of at least one group within each site, and an identification of at least one user within each group; and

collect input from the administrator comprising a set of shipping policy rules for each of said groups and for each of said sites.

4. (Withdrawn) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:

collect from an administrator of an enterprise an identification of at least one sub-administrator user within the enterprise; and

collect input from the administrator comprising a set of shipping policy privileges for each such sub-administrator.

5. (Withdrawn) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:

restrict shipping options available to each user within an enterprise according to input from an administrator of the enterprise of shipping policy rules.

6. (Withdrawn) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:

display graphic user interface shipping selection options to a particular user within an enterprise according to shipping policy restrictions input by an administrator of the enterprise.

7. (Currently Amended) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:

receive in response to a request by a first user within an enterprise to ship a parcel, generate a printable bar-coded pre-processing traveler label, wherein the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels, and wherein the request comprises a set of partial shipment information, wherein the printable bar-coded pre-processing traveler label contains the set of partial shipment information, and wherein the set of partial shipment information comprises at least one of: a destination name, a destination address, a return name, a return address, or

package information;

in response to the request by the first user to ship the parcel: (A) generate a printable bar-coded pre-processing traveler label, wherein the printable bar-coded pre-processing traveler label comprises at least a machine-readable code, and (B) print the printable bar-coded pre-processing traveler label, wherein said printed printable bar-coded pre-processing traveler label comprises an expression of the machine-readable code; [[and]]

receive an input for delegate-finalizing a shipping label for shipping the parcel[, to]] from a second user within the enterprise, wherein the second user is designated in the memory accessible by the computer system as authorized to finalize shipping labels; and

generate a shipping label comprising at least a first item of information from the set of partial shipment information and according to the input from the second user.

8. (Withdrawn) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:

calculate, for each carrier authorized by an administrator of an enterprise for use by a particular user within the enterprise, shipping rates in response to a rating request by the particular user for shipping a particular package.

9. (Withdrawn) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:

generate in response to a rating request by a particular user within an enterprise for shipping a particular package a comparison display of shipping rates for each of a plurality of services offered by each carrier authorized by an administrator of the enterprise for use by the particular user.

10. (Currently Amended) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:

according to a first set of instructions input by an administrator of an

Application Serial No. 09/820,377

Amendment and Response with Request for Continued Examination

enterprise, designate in a memory accessible by the computer system, a first shipping privilege setting identifying each user of a plurality of a first users within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests; and

according to a second set of instructions input by the administrator, designate in the memory, a second shipping privilege setting identifying at least a second user within the enterprise as authorized to print shipping labels according to a pre-processing shipping request by any user of the plurality of users.

11. (Currently Amended) The computer system of Claim 10, said computer system further programmed to:

recognize as a particular pre-processing shipping request to generate a printable bar-coded pre-processing traveler label containing partial shipment information, a particular request input by [[the]]a first user to ship a particular package, wherein the particular request to ship the particular package comprises at least one of: a destination name, a destination address, a return name, a return address, or package information.

12. (Currently Amended) The computer system of Claim 10, said computer system further programmed to:

receive a particular pre-processing shipping request by a first user to ship a particular package, wherein the particular pre-processing shipping request comprises at least one of: a destination name, a destination address, a return name, a return address, or package information;

generate an internal system tracking number in response to [[a]]the particular pre-processing shipping request by the first user; and

save said internal system tracking number corresponding to the pre-processing shipping request in the memory.

13. (Currently Amended) The computer system of Claim 10, said computer system further programmed to:

receive a particular pre-processing shipping request by a first user to ship a particular package, wherein the particular pre-processing shipping request comprises at least one of: a destination name, a destination address, a return name, a return address, or package information; and

generate a printable bar-coded pre-processing traveler label containing partial shipment information in response to [[a]]the particular pre-processing shipping request by the first user, wherein the printable bar-coded pre-processing traveler label comprises at least one of: a destination name, a destination address, a return name, a return address, or package information.

14. (Currently Amended) The computer system of Claim 12, said computer system further programmed to:

generate a printable bar-coded pre-processing traveler label in response to [[a]]the particular pre-processing shipping request by the first user, wherein the printable bar-coded pre-processing traveler label comprises: (A) a bar-coded expression of the internal system tracking number, and wherein the printable bar-coded pre-processing traveler label comprises (B) a machine-readable expression of a set of partial shipment information, wherein the set of partial shipment information comprises at least one of: a destination name, a destination address, a return name, a return address, or package information.

15. (Withdrawn) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:

generate in response to a link creation request by a particular user within an enterprise a hypertext link comprising a linkable address on a server computer, said address on said server computer comprising an entry point to a set of programming instructions for rating shipment of a package characterized by a set of parameters according to a set of shipping policy rules identified by an administrator of the enterprise and according to input by the particular user.

16. (Withdrawn) The computer system of Claim 15, said computer system

Application Serial No. 09/820,377

Amendment and Response with Request for Continued Examination

further programmed to:

save in response to a save link request by the particular user an entry in a saved packages list, said entry comprising an expression of said hypertext link.

17. (Withdrawn) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:

calculate, for each carrier authorized by an administrator of an enterprise for use by a particular user within the enterprise, enterprise shipping rates and custom customer shipping rates in response to a rating request by the particular user for shipping a particular package.

18. (Withdrawn) A method of structuring data relationships for an online, Internet-based, -based, multi-carrier, multi-parcel shipping management computer system, said method comprising:

enabling at least one user in an enterprise as an administrator for the enterprise with authority to set shipping parameter specifications for the enterprise.

19. (Withdrawn) The method of Claim 18, said method further comprising:

collecting from the administrator input identifying a plurality of sites within the enterprise;

establishing a relationship between each site identification and the enterprise; and

storing each of said site identifications and each corresponding relationship to the enterprise in a database.

20. (Withdrawn) The method of Claim 19, said method further comprising:

collecting from the administrator input identifying shipping policy rules for each of said sites; and

storing the shipping policy rules for each site in the database.

Application Serial No. 09/820,377

Amendment and Response with Request for Continued Examination

21. (Withdrawn) The method of Claim 18, said method further comprising:

collecting from the administrator input identifying a plurality of sites within the enterprise wherein each site is characterized by a relationship to the enterprise;

collecting from the administrator an identification of at least one group within each site wherein each group is characterized by a relationship to a particular site;

collecting from the administrator an identification of at least one user within each group wherein each user is characterized by a relationship to a particular group; and

storing each of said site identifications, each of said group identifications, and each of said user identifications in a database.

22. (Withdrawn) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:

calculate, for each carrier authorized by an administrator of an enterprise for use by a particular user within the enterprise, enterprise shipping rates or custom customer shipping rates in response to a rating request by the particular user for shipping a particular package according to shipping policy rules established by the administrator.

23. (Currently Amended) The shipping management computer system of Claim 7, said shipping management computer system further programmed to:

(1) generate for the printable bar-coded pre-processing traveler label [[a]]the machine-readable code;

(2) save in [[a]]the memory accessible by the computer system, an association between the machine-readable code and the request by the first user to ship the parcel; and

(3) print a traveler label, wherein said traveler label comprises an expression of the machine-readable code save the set of partial shipment information in the memory; and

(4) save an association between the machine-readable code and
the set of partial shipment information in the memory.

24. (Currently Amended) The shipping management computer system of Claim 23, said shipping management computer system further programmed to:
recognize as a completion request for the completion of the request by the first user to ship the parcel, a scan by the second user of the expression of the machine-readable code from the printed printable bar-coded pre-processing traveler label.
25. (Previously Presented) The shipping management computer system of Claim 24, said shipping management computer system further programmed to:
complete the request by the first user to ship the parcel with information input by the second user.
26. (Currently Amended) The computer system of Claim 13, said computer system further programmed to:
generate a system tracking number in response to the particular pre-processing shipping request by the first user
generate wherein the printable bar-coded pre-processing traveler label compris[[es]]ing a representation of a machine-readable expression of a system tracking number for tracking the parcel within the enterprise.

Application Serial No. 09/820,377
Amendment and Response with Request for Continued Examination

RESPONSE AND REMARKS

This is in response to the Office Action regarding the above-identified application dated April 21, 2005, which was designated a final rejection.

Amendments to Claims 7, 10-14, 23-24, and 26 are filed concurrently herewith to more distinctly claim the claimed invention. Original Claims 1-6, 8, 9, and 15-22 were previously withdrawn without prejudice. Entry of the amendments, and reconsideration of the application, as amended, are respectfully requested in view of the following remarks.

CLAIM OBJECTIONS UNDER 35 U.S.C. § 132 (a)

In the Final Office Action, the Examiner objected to earlier-filed amendments under 35 U.S.C. § 132 (a) as introducing new matter not supported by the original specification. Specifically, the Examiner objected to the limitation:

...the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels.

In the Final Office Action, the Examiner stated that "the specification talks about users being able to finalize shipping labels, but not specifically disclose the system designating users as being 'restricted from finalizing the shipping labels', and the phrase 'partial shipment information' does not appear in the specification...". In the Final Office Action, the Examiner concluded that the specification does not support the objected to limitations and stated that "[a]pplicant is required to cancel the new matter in reply to this Office Action." In the Final Office Action, the Examiner did not identify the specific Claims objected to under Section 132(a) but later rejected Claims 7, 11, 13 and 14 under 35 U.S.C. § 112, first paragraph, on similar grounds "as failing to comply with the written description requirement."

The Examiner's objections have been carefully considered. It is respectfully submitted, for the reasons given below, that the previously-filed amendments did not add any new matter and that the "restricted from finalizing shipping labels" limitation and the "partial shipment information" limitation are

Application Serial No. 09/820,377

Amendment and Response with Request for Continued Examination

both fully supported by the specification as required under the first paragraph of 35 U.S.C. § 112 and do not introduce new matter as prohibited under 35 U.S.C. § 132 (a).

The "Restricted From Finalizing Shipping Labels" Limitation

It is respectfully submitted that the only claim in which the specific objected-to "restricted from finalizing shipping labels" limitation appears, is Claim 7. However, Claim 10 (as it was originally filed and also as it was previously amended) provided a similar limitation. As originally filed, Claim 10 recited: "... designate a particular user within an enterprise as restricted from printing shipping labels according to instructions input by an administrator of the enterprise." As previously amended, Claim 10 recited: "designate in a memory accessible by the computer system, a first shipping privilege setting identifying a first user within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests ...".

First, because the recitation "... designate a particular user within an enterprise as restricted from printing shipping labels according to instructions input by an administrator of the enterprise" was provided by an original claim, namely Claim 10, that recitation was part of the specification, and therefore satisfies the written description requirement under section 112. See Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989, 998, n.4, (Fed. Cir. 2000), cert. denied, 121 S. Ct. 1167 (2001) ("One of this court's predecessor courts clarified that disclosure in an originally filed claim satisfies the written description requirement. See In re Gardner, 480 F.2d 879, 880 (CCPA 1973) ("Under these circumstances, we consider the original claim in itself adequate 'written description' of the claimed invention. It was equally a 'written description' whether located among the original claims or in the descriptive part of the specification.").").

It is respectfully submitted that the recitation "... designate a particular user within an enterprise as *restricted from printing shipping labels* according to instructions input by an administrator of the enterprise", provided by an original

claim, namely Claim 10, is support by the specification as required under the first paragraph of 35 U.S.C. § 112 for one form of "restricted from finalizing shipping labels" in that printing a shipping label is one form of finalizing a shipping label.

It is therefore respectfully submitted that, because the recitation "... designate a particular user within an enterprise as restricted from printing shipping labels according to instructions input by an administrator of the enterprise" was provided by an original claim, and because that original claim language supports the objected-to limitation, the claims as amended do not introduce new matter.

Further, it is respectfully submitted that that the below-cited references to the specification, for example, when read together, support the objected-to "restricted from finalizing shipping labels" limitation:

1.) "Administrator-established privileges [on a System database 52 (see, e.g., Published Application (US 2002/0032573 A1), Specification, paragraphs 0116 -0118)] for each particular User controls the functionality available to the particular User.... The System provides the administrator the ability to assign User privileges such as: ... Ability to print shipping labels vs. traveler labels, by Carrier or by service..."(Published Application (US 2002/0032573 A1), Specification, paragraphs 0130 - 0134);

2.) "For shipping circumstances in which a User is not allowed to print an actual shipping label, Users can print "traveler" labels, which help identify pre-processed packages for mailroom personnel to complete." (Published Application (US 2002/0032573 A1), Specification, paragraph 0413);

3.) "In one exemplary embodiment of the invention, the Desktop User is either not authorized by the Administrator to print Shipping Labels, or is limited by the Administrator to printing Shipping Labels for only certain types of packages, e.g., Letters. In such an embodiment, the Administrator enables a Shipping Station for the Desktop User. In some cases, a particular Desktop User may decide to not finalize shipping and delegate the actual shipping to some other user within the Enterprise. For example, if the Desktop User is not certain of the weight of a package, the Desktop User, even if that user has shipping lab[el] printing privileges, may decide to print a traveler label, attach the traveler label to the package, and forward the package to a Shipping Station User to complete

Application Serial No. 09/820,377

Amendment and Response with Request for Continued Examination

shipping." (Published Application (US 2002/0032573 A1), Specification, paragraph 0447).

4.) Referring to FIG. 55, the specification explains that "[t]he User enters package and shipping information 335 which is stored in the System databases 336. The User requests printing of a traveler label, which the System prints on a printer local to the User 340. The User delivers the package together with the traveler label to the Shipping Station. The Shipping Station then scans in the Traveler Label 341 in order to retrieve the package and shipping information from the System's databases 342-344 to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label 345-351. This application is used, for example, where Desktop Users have no way of weighing each package." (Published Application (US 2002/0032573 A1), Specification, paragraph 0448);

5.) Referring to FIG. 56 (which depicts an exemplary traveler label), the specification further explains that "[a]s was described above in relation to 345-351 depicted in FIG. 55, the System uses the retrieved package and shipping information, e.g., 363 and 364, to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label." (Published Application (US 2002/0032573 A1), Specification, paragraph 0449).

It is respectfully submitted that, e.g., the citation to the Specification in 3.) above that "the Desktop User is either not authorized by the Administrator to print Shipping Labels ..." supports the objected-to "restricted from finalizing shipping labels" limitation in that printing shipping labels is one form of finalizing shipping labels. Further, it is respectfully submitted that, e.g., the citation to the Specification in 4.) above that after "[t]he User requests printing of a traveler label ...", "[t]he Shipping Station then scans in the Traveler Label ... in order to retrieve the package and shipping information from the System's databases ... to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label ..." supports the objected-to "restricted from finalizing shipping labels" limitation in that the user described as requesting printing of a Traveler Label did not finalize the corresponding shipping label; the corresponding shipping label was finalized via the described Shipping Station.

It is respectfully submitted that, because the above-cited references, read together, fully support the objected-to "restricted from finalizing shipping labels" limitation, the claims as previously amended, and as currently amended, do not introduce new matter.

The "Partial Shipment Information" Limitation

It is noted that Claims 7, and 11-14 contain the objected-to "partial shipment information" limitation.

Although the specific term "partial shipment information" is not expressly recited in the specification, it is respectfully submitted that the below-cited references to the specification, for example, when read together, fully support the "partial shipment information" limitation:

1.) "As will be described in more detail below, a "traveler" label is not an actual shipping label. Rather, a traveler label is a pre-processing label that the User chooses to print and then provides with the package to an Enterprise Shipper; the receiving Enterprise Shipper uses the traveler label to complete the processing necessary to print a shipping label." (Published Application (US 2002/0032573 A1), Specification, paragraph 0125);

2.) "The administrator can define the traveler label format to be used. The traveler label includes a bar code that, when scanned, enables quick retrieval of the shipment record from the System by mailroom personnel using the Ship Station client." (Published Application (US 2002/0032573 A1), Specification, paragraph 0414);

3.) Referring to FIG. 55, the specification explains that "[t]he User enters package and shipping information 335 which is stored in the System databases 336. The User requests printing of a traveler label, which the System prints on a printer local to the User 340. The User delivers the package together with the traveler label to the Shipping Station. The Shipping Station then scans in the Traveler Label 341 in order to retrieve the package and shipping information from the System's databases 342-344 to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label 345-351. This application is used, for example, where Desktop Users have no way of weighing each package." (Published Application (US 2002/0032573 A1), Specification, paragraph 0448);

Application Serial No. 09/820,377
Amendment and Response with Request for Continued Examination

4.) FIG. 56 is a graphic representation depicting an exemplary Traveler Label in an exemplary embodiment of the invention. As depicted in FIG. 56, a Traveler Label reports Shipping Addresses 363, Package Information Details 364, and an instruction to take the package to the appropriate shipping counter 361. Further, the Traveler Label provides a System Tracking Number 362 and a bar code label 360. When the User delivers the package together with the traveler label as depicted in FIG. 56 to the appropriate Shipping Station, personnel at the Shipping Station scans the bar code 360 in the Traveler Label in order to retrieve the package and shipping information, e.g. 363 and 364, from the System's databases. (Published Application (US 2002/0032573 A1), Specification, paragraph 0449).

5.) Referring to FIG. 56 (which depicts an exemplary traveler label), the specification further explains that "[a]s was described above in relation to 345-351 depicted in FIG. 55, the System uses the retrieved package and shipping information, e.g., 363 and 364, to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label." (Published Application (US 2002/0032573 A1), Specification, paragraph 0449).

It is respectfully submitted that, e.g., the action described in the Specification citation in 5.) above to "rate the shipment and finalize the shipping process and complete a shipping label" supports the objected-to "partial shipment information" limitation in that the action to "rate the shipment and finalize the shipping process and complete a shipping label" shows that rating was needed to finalize the shipping process and complete the shipping label; that is, until rating, shipment information is partial.

It is respectfully submitted that, because the above-cited references to the specification, when read together, fully support the objected-to "partial shipment information" limitation, the claims as previously amended, and as currently amended, do not introduce new matter.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

In the Final Office Action, the Examiner rejected Claims 7, 11, 13 and 14 under 35 U.S.C. § 112, first paragraph, "as failing to comply with the written description requirement." The Examiner referred to the above-outlined

Application Serial No. 09/820,377

Amendment and Response with Request for Continued Examination

"objection to amendment" as grounds for the Section 112 rejection, saying that "[t]he claims(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

For the reasons described above with respect to the objection under Section 132(a), it is respectfully submitted that the specification supports both the objected-to "restricted from finalizing shipping labels" limitation and the objected-to "partial shipment information" limitation, that the previously-filed and currently-filed amendments do not add new matter, and that, therefore, the claims comply with the written description requirement under Section 112, first paragraph.

It is respectfully noted that the Examiner stated no other ground for rejecting Claims 23-26 (which are dependent on Claims in the Claim 7, or 10-14 families) other than the Section 112 and 132(a) grounds.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(e)

In the Final Office Action, the Examiner rejected Claims 7 and 10-14 as being anticipated by Stefik et al., (US Publication No. 2003/0115144; "Stefik").

In rejecting Claims 7 and 10-14, the Examiner considered "the system of Stefik to be fully capable of generating a printable bar-coded pre-processing traveler label, in response to a ship request due to the fact that this is considered to be intended use." Citing Ex parte Masham, 2 U.S.P.Q.2d 1647 (1987) and In re Paulsen 30 F.3d 1475 (Fed. Cir. 1994), the Examiner stated that "[i]t has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations." The Examiner reasoned that Stefik discloses "the computer system assigning rights of access to digital works..." and "is fully capable of designating a first user in a memory accessible by the computer system as restricted from finalizing shipping labels, and wherein the printable bar-coded pre-processing traveler label contains partial shipment information..." The Examiner concluded, on the basis of Ex parte Masham and In

Application Serial No. 09/820,377

Amendment and Response with Request for Continued Examination

re Paulsen, that "the computer system of Stefik [is] fully capable of delegating finalizing a shipping label for shipping the parcel to a second user within the enterprise, wherein the second user is designated in the memory accessible of the computer system as authorized to finalize shipping labels."

In the Final Office Action, the Examiner rejected Claims 10-14, similarly finding the Stefik system "fully capable" of the subject matter of Claims 10-14.

REMARKS REGARDING THE SECTION 102(e) REJECTION

The Examiner's rejections under Section 102(e) have been carefully considered. Claims 7, 10-14, 23-24, and 26 have been amended. For the reasons given below, it is respectfully submitted that Stefik does not disclose or suggest, nor do any of the other references of record disclose or suggest, all of the limitations of amended independent Claims 7 and 10, or the claims dependent on them.

Independent Claim 7

Amended independent Claim 7 is directed to an online, Internet-based, multi-carrier, multi-parcel shipping management computer system that is programmed to:

receive a request by a first user within an enterprise to ship a parcel, wherein the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels, wherein the request comprises a set of partial shipment information, wherein the printable bar-coded pre-processing traveler label contains the set of partial shipment information, and wherein the set of partial shipment information comprises at least one of: a destination name, a destination address, a return name, a return address, or package information;

in response to the request by the first user to ship the parcel: (A) generate a printable bar-coded pre-processing traveler label, wherein the printable bar-coded pre-processing traveler label comprises at least a machine-readable code, and (B) print the printable bar-coded pre-

processing traveler label, wherein said printed printable bar-coded pre-processing traveler label comprises an expression of the machine-readable code;

receive an input for finalizing a shipping label for shipping the parcel from a second user within the enterprise, wherein the second user is designated in the memory accessible by the computer system as authorized to finalize shipping labels; and

generate a shipping label comprising at least a first item of information from the set of partial shipment information and according to the input from the second user.

It is respectfully asserted that the prior art references cited by the Examiner do not teach or suggest all of the limitations of amended independent Claim 7. One advantage of an online, Internet-based, multi-carrier, multi-parcel shipping management computer system according to various embodiments of the system claimed in amended Claim 7 is that such embodiments allow some users within an enterprise to request a shipment of a package and identify information for shipping the package even if those users do not have all of the information necessary for completion of a shipping label for the package. For example, such users may not have immediate access to a postal scale for weighing a package. Such embodiments allow a second user within the enterprise to complete a shipping label for shipping the package with information available to the second user but that may not have been available to the requesting user.

In view of the above-given reasons that the prior art references cited by the Examiner do not teach or suggest all of the limitations of amended independent Claim 7, it is respectfully asserted that the prior art references cited by the Examiner do not teach or suggest all of the limitations of Claims 23-25, that are, in one way or another, dependent on Claim 7.

Application Serial No. 09/820,377
Amendment and Response with Request for Continued Examination

Independent Claim 10

Amended Independent Claim 10 is directed to an online, Internet-based, multi-carrier, multi-parcel shipping management computer system that is programmed to:

according to a first set of instructions input by an administrator of an enterprise, designate in a memory accessible by the computer system, a first shipping privilege setting identifying each user of a plurality of users within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests; and

according to a second set of instructions input by the administrator, designate in the memory, a second shipping privilege setting identifying at least a second user within the enterprise as authorized to print shipping labels according to a pre-processing shipping request by any user of the plurality of users.

One advantage of an online, Internet-based, multi-carrier, multi-parcel shipping management computer system according to various embodiments of the system claimed in amended independent Claim 10 is that such embodiments allow an administrator within an enterprise to designate some users within the enterprise as authorized to request a shipment of a package, but as restricted from printing shipping labels -- for example, users within the enterprise that do not have all of the information, such as, for example, the weight of a package, that would be necessary for completion of a shipping label for a package, could be designated by the administrator as authorized to request a shipment of a package, but as restricted from printing shipping labels. Such embodiments allow the administrator to designate at least a second user within the enterprise, such as, for example, a postal clerk within the enterprise who has access to scales to accurately weigh each package, to complete a shipping label for shipping the package with information available to the second user but that may not have been available to requesting users.

In view of the above-given reasons that the prior art references cited by the Examiner do not teach or suggest all of the limitations of amended

- Application Serial No. 09/820,377
Amendment and Response with Request for Continued Examination
- independent Claim 10, it is respectfully asserted that the prior art references cited by the Examiner do not teach or suggest all of the limitations of Claims 11-14, and Claim 26, that are, in one way or another, dependent on Claim 10.

CONCLUSION

In view of the foregoing amendments, and for the foregoing reasons and authorities, it is respectfully submitted that the invention disclosed and claimed in the present amended application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of the amended application.

Respectfully submitted,

KHORSANDI PATENT LAW GROUP, ALC

By _____


Marilyn R. Khorsandi
Reg. No. 45,744
626/796-2856

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE PATENT MAINTENANCE
DIVISION

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop 16, Director of the USPTO, P.O. Box 1450, Alexandria, VA 22313-1450 on October 11, 2005.

Marilyn R. Khorsandi
Marilyn R. Khorsandi

US MAIL - FIRST CLASS
OFFICE

Applicant : Daniel F. Williams, et al.
Application No. : 09/820,377
Filed : March 27, 2001
Title : Apparatus, Systems and Methods For Online, Multi-Parcel, Multi-Carrier, Multi-Service Enterprise Parcel Shipping Management
Grp./Div. : 3629
Examiner : Jamisue A. Webb
Docket No. : PSTM0041/MRK

COPY

TRANSMITTAL LETTER

Mail Stop 16
Director of the USPTO
P.O. Box 1450
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312
Pasadena, CA 91101
October 11, 2005

Commissioner:

Attached are the following:

1. Request for Refund Letter;
2. Copy of July 20, 2005 Amendment and Response with Request for Continued Examination; and
3. Return Postcard.

The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17 which may be required during the pendency of this application to Deposit Account No. 501574. Please show our docket number with any charge or credit to our Deposit Account. A copy of this letter is enclosed.

Respectfully submitted,

KHORSANDI PATENT LAW GROUP, ALC

By *Marilyn R. Khorsandi*

Marilyn R. Khorsandi
Reg. No. 45,744
Customer No. 29524
626/796-2856

MRK/aa
Enclosures

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop 16, Director of the USPTO, P.O. Box 1450, Alexandria, VA 22313-1450 on October 11, 2005.

Marilyn R. Khorsandi
Marilyn R. Khorsandi USPA

Applicant : Daniel F. Williams, et al.
Application No. : 09/820,377
Filed : March 27, 2001
Title : Apparatus, Systems and Methods For Online, Multi-Parcel, Multi-Carrier, Multi-Service Enterprise Parcel Shipping Management
Grp./Div. : 3629
Examiner : Jamisue A. Webb
Docket No. : PSTM0041/MRK

TRANSMITTAL LETTER

Mail Stop 16
Director of the USPTO
P.O. Box 1450
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312
Pasadena, CA 91101
October 11, 2005

Commissioner:

Attached are the following:

1. Request for Refund Letter;
2. Copy of July 20, 2005 Amendment and Response with Request for Continued Examination; and
3. Return Postcard.

The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17 which may be required during the pendency of this application to Deposit Account No. 501574. Please show our docket number with any charge or credit to our Deposit Account. A copy of this letter is enclosed.

Respectfully submitted,

KHORSANDI PATENT LAW GROUP, ALC

By Marilyn R. Khorsandi
Marilyn R. Khorsandi
Reg. No. 45,744
Customer No. 29524
626/796-2856

MRK/aa
Enclosures

O I P E
JUL 26 2005
U.S. PATENT & TRADEMARK OFFICE
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 20, 2005.

Marilyn R. Khorsandi
Marilyn R. Khorsandi

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Daniel F. Williams, et al.
Application No. : 09/820,377
Filed : March 27, 2001
Title : APPARATUS, SYSTEMS AND METHODS FOR
ONLINE, MULTI-PARCEL, MULTI-CARRIER, MULTI-SERVICE
ENTERPRISE PARCEL SHIPPING
MANAGEMENT
Grp./Div. : 3629
Examiner : Webb, Jamisue A.
Docket No. : PSTM0041/MRK

AMENDMENT AND RESPONSE
WITH REQUEST FOR CONTINUED EXAMINATION

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312
Pasadena, CA 91101-4710
July 20, 2005

Commissioner:

In reply to the Office Action regarding the above-identified application, dated April 21, 2005, which was designated a final rejection, a Request for Continued Examination and the associated fee are submitted herewith, and consideration of the application in view of the Amendments and the Response and Remarks below is respectfully requested.

Amendments to the Claims are reflected in the Listing of Claims that begins on page 2 of this paper.

Response and Remarks begin on page 10 of this paper.

18/02/2005 GJOHNSON 00000001 501574 09820377

01 FC:1202 200.00 DA

- 1 -

Adjustment date: 12/01/2005 SDENB0B1
08/02/2005 GJOHNSON 00000001 501574 09820377
01 FC:1202 200.00 CR

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- BLACK BORDERS**
- IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- FADED TEXT OR DRAWING**
- BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- SKEWED/SLANTED IMAGES**
- COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- GRAY SCALE DOCUMENTS**
- LINES OR MARKS ON ORIGINAL DOCUMENT**
- REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.